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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Henrik Sune ANDERSEN et al.

Serial No.: 09/659,622 Group Art Unit: 1646

Filed: September 11, 2000 Examiner: Kevin E. WEDDINGTON

For: METHOD OF INHIBITING PROTEIN TYROSINE PHOSPHATASE 1B AND/OR 5-CELL PROTEIN TYROSINE PHOSPHATASE AND/OR OTHER PTPASES WITH AN ASP RESIDUE AT POSITION48

RESPONSE TO RESTRICTION REQUIREMENT AND SPECIES ELECTION REQUIREMENT

Hon. Commissioner of
Patents and Trademarks
Washington, DC 20231

Sir:

In response to the restriction requirement mailed February 22, 2002, applicants respond as follows.

I. **Restriction Requirement**

The Examiner requires election of one of groups I to X. Applicants elect, with traverse, the Group I claims, covering a method of inhibiting at least one intracellular or membrane associated PTPase that has aspartic acid in position 48 (using the numbering of PTP1B) with an inhibitor compound of moieties I-XXXVII.

Applicants traverse the restriction requirement on the grounds that there are similarities in the subject matter of all groups I-X, so that all Groups I to X do not present an unfair search and examination burden on the Examiner. The Examiner is reminded that under M.P.E.P. §803 if the search and examination of "an entire application" (or in this case the subject matter of Groups I-X) can be made "without serious burden," then the Examiner "must examine it on the merits."

There is common subject matter in claims 1-10. As an illustration, the only significant difference in claim scope between Group I (claim 1) and Group II (claim 2) is the identification of moiety I, which is a phosphate isotere in Group I (claim 1), and an oxalylamide in Group II (claim 2). The other characteristics of the I moiety are the same in both claims.

Each of Groups III to X (claims 3 to 10) cover methods of inhibiting at least one PTPase consisting of PTP1B, TC-PTP and other PTPase that are structurally similar to PT1B, in which, as in claims 1 and 2, there are significant common features of the inhibitory compound.

As a result, there is no undue burden on the Examiner to search the subject matter of all Groups I to X in this application.

II. Species Election Requirement

The Examiner also requires a species election of a specific moiety (from moieties I to XXXVIII) from the elected claim group. Applicants elect (with traverse) the moiety I, which is defined (in claim 1) as follows:

> a phosphate isotere which forms a salt bridge to the guanidinium group of arginine 221 and a hydrogen bond with a hydrogen atom donated by the backbone amide nitrogens of arginine 221 and glycine 220 such that the distance between the centroid of said guanidinium group angles from 3.50 to 4.20 Å, (II) said arginine 221 backbone amide nitrogen ranges from 3.5 to 4.2 Å, and (III) said glycine 220 backbone amide nitrogen ranges from 2.7 to 3.5 Å.

Applicants traverse the species election requirement, on the grounds that the claims require the presence of features I, II and III, and one of IV and V, and one or more of VI to XXXVII. As a result, limiting the species election to one of groups I to XXXVII does not reflect the invention as claimed. Further, the presence of four separate structural features is believed to limit the claims to a scope that can effectively be searched and examined in a single application.

As a result, the Examiner is requested to withdraw the species election requirement.

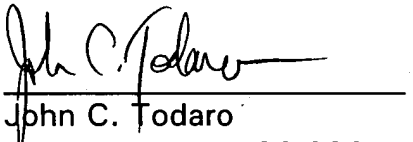
III. Conclusion

In view of the foregoing, applicants elect the Group I claims (in response to the restriction) and moiety I (in response to the species election). In view of the arguments made, the Examiner is requested to withdraw the restriction requirement and species election requirement, and rejoin the subject matter of all pending claims in this application.

Favorable action is earnestly solicited.

Respectfully submitted,

Dated: July 22, 2002



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